

Appl. No. 09/921,003
Reply to Office Action Oct. 3, 2006

REMARKS/ARGUMENTS

This Response is in response to the Office Action mailed on October 3, 2005 ("Office Action"). Claims 1-14 were rejected. Review and reconsideration are requested in view of the following remarks.

Rejection of Claims 1-14 under 35 U.S.C. § 102(e)

Claims 1-14 were rejected under 35 U.S.C. § 102(e) as being anticipated by US Patent No. 6,721,713 (Guheen). Applicant respectfully traverses the rejection.

Claims 1-14 were rejected as being anticipated under section 102(e) by Guheen Section 102(e) reads, in relevant part, that "A person shall be entitled to a patent unless –

(e) the invention was described in (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent ..."

Section 102 requires that, for a reference to anticipate, it must disclose each and every element of the claimed invention. Therefore, in particular, for section 102(e) to apply herein, Guheen must disclose each and every element of the instant claimed invention. Applicant respectfully contends that Guheen does not disclose each and every element of the instant claimed invention and therefore does not qualify as 102(e) prior art in the instant case. Applicant asserts that Guheen fails to do so for the following reasons:

With respect to independent claim 1, the Office Action contends that claim 1 is anticipated by Guheen. Specifically, the Office Action contends that Guheen discloses "a computer program product including means for comparing (comparing products/services) a URL, title and/or content of an online site viewed by a user with a first index of keywords relating to a plurality of subject matter categories, to determine any subject matter categories to which the online site relates; means for cross-referencing any determined subject matter categories with a second index of alternative online sites categorized by subject matter, in order to determine any alternative online site in the same or similar category; and means for displaying

Appl. No. 09/921,003
Reply to Office Action Oct. 3, 2006

any determined alternative online sites to the user.” The Office Action cites to Guheen col. 170, lines 30-66; col. 178, lines 20-36; and col. 187, lines 1-65 to support the contention that claim 1 of the instant application is anticipated by Guheen (USPTO Office Action dated 08/03/2005, p. 2). Applicant respectfully disagrees.

Nowhere in the cited passages does Guheen teach a computer program as claimed in claim 1 including, for example, “a means for cross-referencing any determined subject matter, with a second index of alternative online sites categorized by subject matter, in order to determine any alternative online sites in the same or similar category; and a means for displaying any determined alternative sites to the user.” Rather, Guheen, in column 170, lines 30-66, and the cited Fig. 66, simply disclose a virtual shopping cart where information from numerous products and vendors is obtained and derived from within a particular online site. Nowhere in the cited passage, however, does Guheen disclose a “means for cross-referencing ... with a second index of alternative online sites ... in order to determine any alternative online sites to the user.” Rather, Guheen discloses an online site where a variety of products can be accessed presumably from the same online site and not from an alternative online site. As stated above, Guheen does not teach the use of alternative online sites as claimed in claim 1. Columns 178 and 187 of Guheen also fail to teach the invention claimed in claim 1. Column 178, lines 20-36, simply describes the use of keywords. Column 187, lines 1-65, simply describes advertising. Therefore, because of the failure of Guheen to teach all of the elements of claim 1 of the instant application, the reference does not anticipate the instant claimed invention.

Applicant contends that Guheen does not anticipate independent claims 5 and 10 of the instant application for the same reasons articulated for claim 1, *supra*. As in claim 1, an alternative online site is referred to in claims 5 and 10. The Office Action cites to col. 170, lines 56-65, of Guheen to support the contention that claims 5 and 10 are anticipated by Guheen. These lines simply disclose that the featured “displayed catalog may be customized based upon the user profile ... [and] the data relating to at least one of the products and services may include a link to related data ... [and] the comparison between different products and services could include identification of at least one advantage of the at least one of products and services ...

Appl. No. 09/921,003
Reply to Office Action Oct. 3, 2006

[and] the recommendation of at least one of the products and services includes a financial analysis of at least one of the products and services." Nowhere in the cited passage of Guheen is found disclosure about alternative online sites. In the cited passage, Guheen simply discloses a single online site that displays to the user a variety of products and vendors, which may be achieved by accessing the information from within its own online site. This is very different from the teachings of the instant application, which disclose a means of querying and displaying information from an alternative online site. Therefore, because Guheen does not disclose a means for "displaying to the user information relating to alternative sites," as claimed in claim 5, or "displaying to the user information relating to competing products on alternative online sites," as claimed in claim 10, claims 5 and 10 of the instant application are not anticipated by Guheen.

Because all other pending claims of the instant application depend from either independent claims 1, 5, or 10, Applicant has not addressed the Office Action's arguments that the dependent claims would be anticipated by Guheen. Since Applicant contends that Guheen does not teach a means to determine alternative online sites or means for displaying any determined alternative online site to the user (as claimed in claim 1) or displaying to the user information relating to alternative online sites (as claimed in claims 5 and 10), claims 1, 5, and 10, are not anticipated by Guheen. Therefore, a priori, all dependent claims flowing from claims 1, 5, and 10 are not anticipated by Guheen.

Appl. No. 09/921,003
Reply to Office Action Oct. 3, 2006

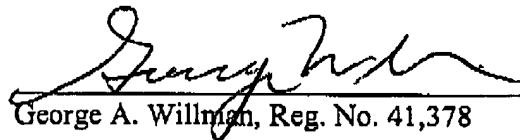
CONCLUSION

Applicant submits that the instant application is in condition for allowance. Should the Examiner have any questions, the Examiner is requested to contact the undersigned attorney.

The Commissioner is authorized to charge any additional fees which may be required, including petition fees and extension of time fees, to Deposit Account No. 23-2415 (Docket No. 25720.702).

Respectfully submitted,

WILSON SONSINI GOODRICH & ROSATI



George A. Willman, Reg. No. 41,378

Date: January 31, 2006

650 Page Mill Road
Palo Alto, CA 94304
(650) 595-3995
Customer No. 021971